

## DETAILED ACTION

### *Response to Amendment*

- 1) The preliminary amendment to the specification is noted. As it adds no new matter into the application (the new claims are combinations of the old claims to comply with Office multiple dependency rules), the amendment is accepted. Currently Claims 1-8 are canceled and Claims 9-12 are pending.

### *Claim Rejections - 35 USC § 103*

- 2) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 3) The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  - (1) Determining the scope and contents of the prior art.
  - (2) Ascertaining the differences between the prior art and the claims at issue.
  - (3) Resolving the level of ordinary skill in the pertinent art.
  - (4) Considering objective evidence present in the application indicating obviousness or nonobviousness.

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- 4) Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Spector et al (U.S. Patent 6,109,748, hereinafter '748) in view of Haga et al (U. S. Patent 5,989,628, hereinafter '628).

- 5) With regard to Claim 9, '748 teaches a method of forming a protective film for an eyeglass lens. '748 teaches coating a solution comprising a copolymer of vinyl chloride/vinyl acetate, acetone and n-amyl acetate onto a lens surface (solution discussed in Column 5 Lines 21-52 and Column 5 Line 61 - Column 6 Line 8). This solution forms a peelable layer when dried (Column 7 Line 52 - Column 8 Line 14). The ratio of components claimed by Applicant is embodied at Column 5 Line 61 - Column 6 Line 8 and Column 7 Lines 1-10. '748 is silent as to the coefficient of friction of the formed film and as to the presence of other coatings on the lens. '628 teaches forming an anti-fogging layer on the inside of a layer of a laminated lens ('748 deals with laminated lenses as well) using a protective film to mask the surfaces of the lens where the anti-fogging layer is not to be applied. This anti-fogging layer is necessarily water-repellent, as fog is condensing water vapor. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have combined the methods of '748 and '628, as both methods are dealing with methods of producing laminated lenses and '628 shows that functional properties can be selectively imparted to the lens by use of protective masking layers. At this point, the only point outstanding is the coefficient of friction of the formed film being greater than that of the lens surface. The polymers disclosed in the prior art are the same as or similar to those disclosed by Applicant

as suitable in the specification, and as the polymer films are disclosed as peelable in the prior art, they must necessarily have a greater coefficient of friction than the lens for the peeling to occur.

- 6) Claim 10 is rejected on the same basis; '628 teaches the interchangeability of vinyl chloride / vinyl acetate and chlorinated polypropylene films (Column 10 Lines 22-35).
- 7) Claim 11 is rejected on the same basis; '748 teaches the use of dip coating, painting and spin coating as application means (Column 7 Lines 62-67).
- 8) Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over '748/'628 as applied to claim 9 above, and further in view of Elias et al (U. S. Patent 4,915,986, hereinafter '986). Claim 12 adds a specific method of dip coating which is not fairly taught by '748/'628. '986 teaches a method of dip-coating an optical lens in a tinting solution which comprises in order fixing the eyeglass lens on a support, lowering the lens into the tinting solution at a desired speed, raising the lens in the solution at a given speed, and ultimately removing the lens from the tinting solution to dry (Column 4 Lines 10-56). '986 teaches both a uniform coating and a gradient coating mode, which will control the thickness of the tinting coating on the surface. '748 expresses an interest in the thickness of the coating on the lens surface, noting that the thickness must be controlled for peelability and protective properties ('748 Column 8 Lines 6-14). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have applied the procedure of '986 to serve as the dip-coating method of '748/'628 since '986 is capable of performing

the required function and provides control over the final thickness of the film, which is desired by '748/628 to control peelability and protection properties.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL G. MILLER whose telephone number is (571)270-1861. The examiner can normally be reached on M-F 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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